IN THE UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
LUFKIN DIVISION

BURNS, MORRIS & STEWART LIMITED PARTNERSHIP, **Plaintiff,** **v.** **ENDURA PRODUCTS, INC.,** **Defendant.**	**Civil Action No. 9:04CV23** **Judge Ron Clark**

DEFENDANT ENDURA

OPENING STATEMENT CLAIM CONSTRUCTION HEARING

On Behalf of Endura Products, Inc.

Counsel

Frank Calvert

Jack Hicks

Bill Capp

DJ Mason

Kevin MacDonald,
Endura (VP Operations)

Charlie Headrick,
Headrick Building Products
(Retained Expert)

Endura's Submissions

- Defendant's Intrinsic Evidence Appendix
- Defendant's Extrinsic Evidence Appendices Vol. I – III
- Prosecution Histories of Related Cases
- Witness Deposition Transcripts, Direct and Cross

Endura's Submissions

- Kevin MacDonald
  - Endura as a company
  - Art of making jambs
  - Endura's Mull Boot and Jambdam™ Frame Adapter Products
- Charlie Headrick
  - Holds numerous patents for entryway components

GUIDING PRINCIPLES

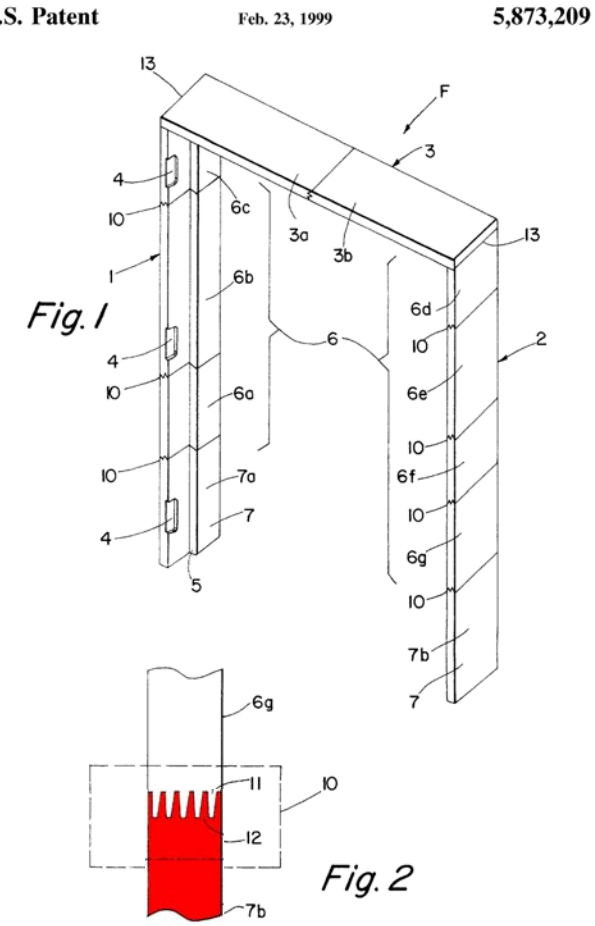
"We have had many occasions to cite one or both of the twin axioms regarding the role of the specification in claim construction: On the one hand, claims 'must be read in view of the specification, of which they are a part.' *[citations omitted]* On the other hand, it is improper to read a limitation from the specification into the claims.

LIEBEL-FLARSHEIM CO., v. MEDRAD, INC., *358 F.3d 898, 69 U.S.P.Q.2d 1801 (Fed. Cir. 2004)*

BACKGROUND

Fall 1995

Rick Hagel conceives of replacing the bottom wood section of a finger-jointed jamb, with a wood-plastic composite.



BMS Patent Family
(Partial List)

S/N 10/238,445
Filed Sep. 9, 2002
Published Jan. 9, 2003
US 2003/0005652A1
Continuation of

S/N 09/621,590
Filed Jul. 21, 2000
USPN 6,446,410
Issued Sep. 10, 2002
continuation of

S/N 09/342,562
Filed Jun. 29, 1999
USPN 6,122,882
Issued Sep. 26, 2000

S/N 09/130,160
Filed Aug. 6, 1998
USPN 5,950,391
Issued Sep. 14, 1999

S/N 08/837,776
Filed Apr. 22, 1997
USPN 5,873,209
Issued Feb. 23, 1999

S/N 08/612,757, Filed Mar. 8, 1996
USPN 5,661,943
Issued Sep. 2, 1997
Frame with Integral Environment resistant members

Others

Wood Rot

Problem has existed for centuries

Solutions:

Using all metal or all composite doorframes

Using non-wood (metal or plastic) parts under jambs (many)

Using durable, fibrous mull pads

Treating wood by dipping/painting

USPN 5,873,209

Issued Feb. 23, 1999

Claim 1: A **frame**, comprising:

a top jamb;

two side jambs having **upper and lower portions** that are **integrally formed**[.]

Claim 4: A constructions component comprising:

a **first portion and a second portion** that are **integrally joined**[.]

Claim 8: …wherein the second portion is **entirely plastic**.

Intrinsic Record Defines Terms

- Endura's Proposed Constructions are consistent with dictionary definitions and with intrinsic record

- BMS seeks to incorporate carefully selected restrictions in order to navigate around prior art, but still reach infringement

Definition of "Frame"

BMS:

- A pre-assembled unit with a top jamb, and two side jambs that is ready for insertion into a door opening in a wall. (emphasis added)

Endura:

- Spaced vertical side jambs connected together at the top by a horizontal top jamb

USPN 5,873,209

Issued Feb. 23, 1999

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a top jamb;

two side jambs having **upper and lower portions** that are **integrally formed**[.]

Claim 4: A construction component comprising:

a **first portion and a second portion** that are **integrally joined**[.]

Claim 8: …wherein the second portion is **entirely plastic**.

"Upper" and "Lower Portions"

BMS:

- The upper portion of a side jamb is that portion which is in contact on an upper end with a top jamb and whose lower end is protected by the lower portion from environmental factors.

- The lower portion is that portion of a side jamb in contact on an upper end with the lower end of an upper portion, that substitutes a material other than natural wood for what would otherwise be natural wood in a standard side jamb thereby protecting the lower end of the upper portion from environmental factors. (emphasis added)

Endura:

- "Portion" means some part that is less than the whole;

- "Upper" means that it is relatively vertically higher than a portion that is lower

- "Lower" means that it is relatively vertically lower than a portion that is upper.

"First" and "Second Portions"

BMS:

- "First portion" referring to a construction component that has at least two discrete portions wherein the first portion has at least one surface in contact with a second portion.

- "Second portion" referring to a construction component that has at least two discrete portions wherein the second portion has at least one surface in contact with the first portion <u>such that the second portion substitutes a material other than natural wood for what would otherwise be natural wood</u>. (emphasis added)

Endura:

- "First portion" is some part that is less than the whole

- "Second portion" is some part that is less than the whole and distinguishable from the 'first' portion

“Entirely Plastic”

BMS:

- None offered.

Endura:

- Exclusively plastic (see definition of plastic above) with no non-plastic materials, such as metal screws or staples.

"Integrally Formed"

BMS:

- Referring to the attachment of the upper and lower portions of a side jamb such that the upper and lower portions are attached to one another so as to achieve a completed side jamb. (emphasis added)

Endura:

- Shaped or formed into a single, indivisible, whole unit, as opposed to an assembly of components attached with removable fasteners, such as screws or staples (emphasis added)

"Integrally Joined"

BMS:

- Referring to the attachment of the first and second portions of a construction component such that the first and second portions are attached to one another so as to achieve a completed construction component. (emphasis added)

Endura:

- Permanently connected into a single, indivisible, whole unit, as opposed to an assembly of components attached with removable fasteners, such as screws or staples (emphasis added)

Integrally Formed/Joined

- Meaning of terms in context of patent - what is referenced and what is not referenced
- Statements by Applicant in 209 prosecution
- Statements by Applicant in related prosecution
- Meaning to those of ordinary skill in art

Patent Prosecution

- Parent case – USPN Words “integrally formed/joined” added after telephone interview with examiner and submission by Applicant of photographs of “integral environment resistant section.”

  [Submitted Feb. 24, 1997]
- After submission, Notice of Allowance Issued [March 13, 1997]

Serial No.:	08/612,757
Group Art Unit:	3504
Examiner:	Y. Horton-Richardson
Applicant:	Richard C. Hagel
Filing Date:	March 8, 1996
Title:	FRAME WITH INTEGRAL ENVIRONMENT RESISTANT MEMBERS
Att. Docket No.	1225-003

EXHIBIT A

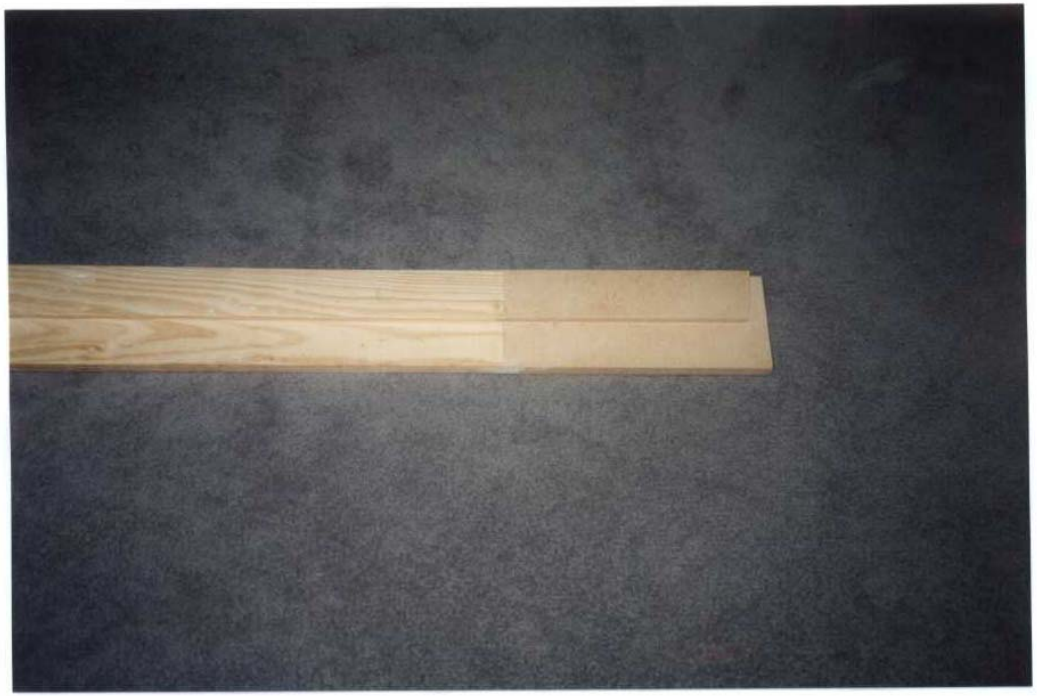

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EXHIBIT B

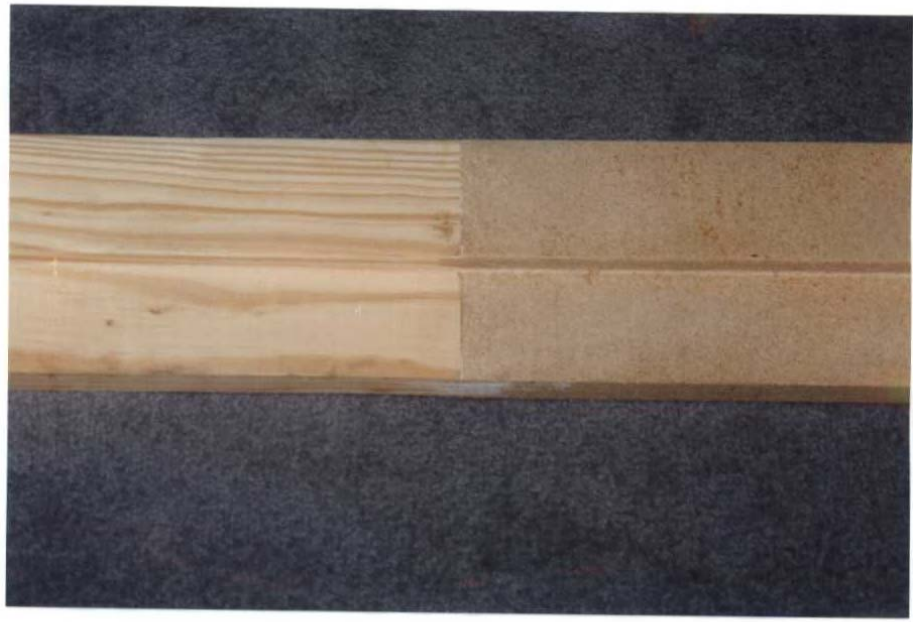

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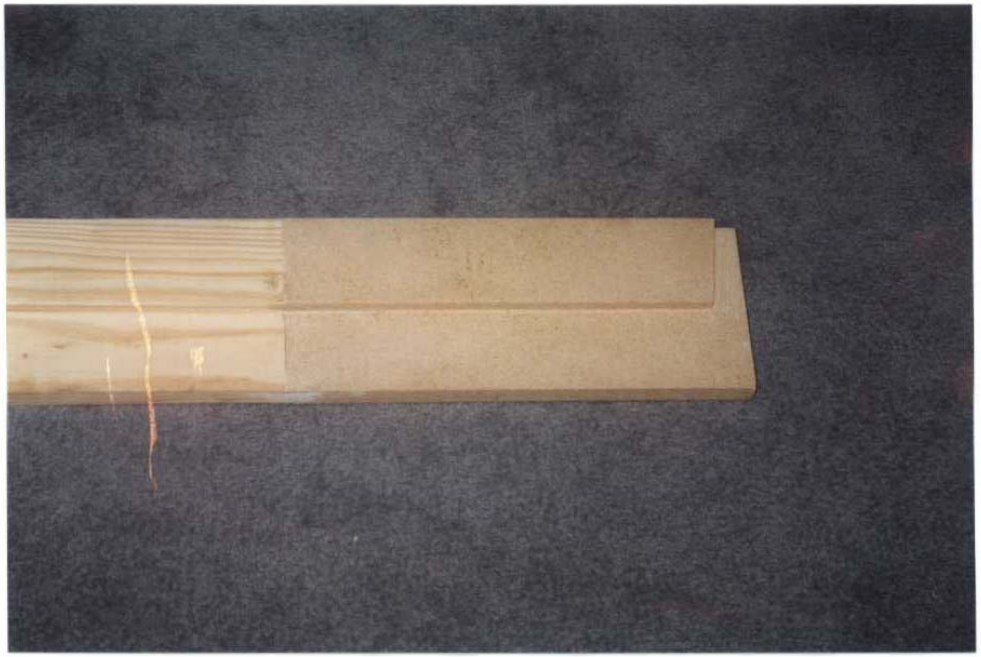
EXHIBIT C



What Is Applicant's Invention?

- Absence of fasteners, i.e., screws, nails, staples—None shown in photographs nor mentioned in specification.

- "[P]ermanently interconnected upper and lower portions; it is not a side jamb to which an extension is (removably) attached on site." Statements by BMS attorney in prosecution of related EPO case, EP 98918380.3, May 19, 2004 (parenthetical in original)

"Integrally" As Used In Art Excludes Fasteners

The molding member 26 is **integrally molded, extruded or otherwise formed** at the same time as the exterior panel 22. Thus, the molding member 26 and the exterior face 20 of the panel 22 are one integrated piece, as best seen in Figs. 2 and 3. **No separate fasteners or fastening operations are required.**

USPN 5,836,120, col 2:42-46 (emphasis added), XP2 p. 50

Where Does BMS Look for Support for Broad Definition of Integral to Include Fasteners?

- Specification language
  - "Mechanical connection"; "metal"
  - Added improperly - violates prohibition of new matter
  - Conflicts with positions taken before other governmental bodies

SUMMARY OF THE INVENTION

The present invention is a [frame]component having durable, yet cost effective characteristics not found in the prior art. In the preferred embodiment, a [door frame]construction component is comprised of a [top]first section and [two side sections. Each side]second section [includes]. The second section is comprised of a [lower portion being both] material that is durable and moisture, decay and insect resistant. The [top]first section [and upper portions are]is comprised of [smaller] wood [pieces]. The wood [pieces] and durable portions are connected end to end with a glued finger joint **or other mechanical connection** to assemble the [door frame. Hinge recesses and strike plate mountings are provided]component. Associated hardware may also be added.

(Showing changes from 943 application to 209 application; Bracketed red are deletions; underscore blue are additions)

DETAILED DESCRIPTION OF PREFERRED EMBODIMENTS

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The durable portion 7 [Is preferably] may be an extruded wood-based product, such as [strandex]STRANDEX.RTM., ERT.RTM., TREX.RTM. or the like, which can be shaped using conventional wood processing techniques, painted or stained. **The durable portion may also be made of plastic, vinyl, metal and combinations of any of these materials.** The durable portion 7 has the characteristics of being moisture, decay and insect resistant. Side jamb 1 includes a durable piece 7a and side jamb 2 includes a durable piece 7b. The placement of the durable portion 7 on the lower portion of the frame prevents all but the most severe weather and insect damage suffered by prior art door frames. The durable pieces 7a and 7b may be proportioned based on the expected exposure to adverse conditions such as rain, snow or insects. Thus, the assembly of the wood portion 6 and the durable portion 7 provides a durable, yet cost effective door frame. It is noted that other materials, such as plastic or similar extrusions, can be used for the durable pieces to achieve the principles of the present invention.

DETAILED DESCRIPTION OF PREFERRED EMBODIMENTS

In the assembly of the side jambs 1 and 2, the durable pieces 7 are preferably connected end to end by a glued finger joint 10 to the wood portions 6. One of the joints 10 is illustrated more clearly in FIG. 2. Referring now to FIG. 2, wood piece 6g includes a number of fingers 11 protruding from an end face and durable piece 7b has a corresponding number of mated fingers 12 protruding from an adjacent end face. It should be understood that other wood joints are contemplated, such as edge gluing or their equivalents.

End of Presentation